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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/375,239	08/16/1999	EZIO MUSSO	P8910-9024	4809

7590 11/30/2001

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/30/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-20

Office Action Summary

Application No.
09/375,239

Applicant(s)
Musso et al.

Examiner
Rabon Sergent

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 3, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 12-18, 22, and 23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 12-18, 22, and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1711

1. Claims 1-3, 10, 12-18, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 1, the language pertaining to sections (2) and (4) renders the claims indefinite, because composition X is being modified by two different weight percent values. It is unclear how one is to be interpreted in view of the other. The language is analogous to the improper practice of claiming a range within a range in the same claim.

Within composition XIII of claim 18, no percent value is specified for the pentane component.

Within claims 15 and 16, it is unclear how to interpret the polyol limitation when thermoplastic polymers are used, which do not rely upon polyols.

Within claims 12, 18, 22 and 23, applicants have claimed compositions which encompass other claimed compositions within the claim. For example, see compositions I and A. It is unclear if the narrow composition is to modify the broad composition. Again, this is considered to be analogous to claiming a range within a range within the same claim.

Within claims 14 and 15, it is unclear how to interpret the water limitation when thermoplastic polymers are used, since these polymers may not utilize water for foaming.

Within claims 1, 2, 18, 22 and 23, despite applicants' response, applicants have used the wrong structural formula in connection with the recited compound name. Furthermore, applicants have recited the wrong formula for the compounds within the response at pages 15 and

Art Unit: 1711

16. Applicants are invited to compare H) in claim 3 with VIII in claim 1. The structure for 1-difluoromethoxy - 1, 1, 2, 2-tetrafluoroethyl difluoromethyl ether is $\text{HCF}_2\text{OCF}_2\text{CF}_2\text{OCF}_2\text{H}$, and the structure for difluoromethoxy - bis (difluoromethyl ether) is $\text{HCF}_2\text{OCF}_2\text{OCF}_2\text{H}$. Applicants are required to check and correct all recitations of the compound with its structure.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 12, 13 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethanes and polyolefins wherein compositions which correspond to applicants' compositions; IV, V, D, and E; are disclosed. See abstract. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be inherently met by the references.

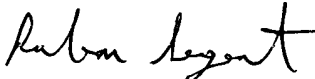
4. Applicants have argued that Klug et al. do not disclose that the compositions will function as substitutes for CFC-11. In response, patentees' compositions are disclosed as being azeotropic; therefore, they comprise the same components in the same amounts as applicants' azeotropic compositions and, consequently, will inherently function as blowing agents to the same extent as applicants' compositions. Additionally, it is unclear with respect to exactly what patentable limitation the language pertaining to CFC-11 substitution conveys to the claim.

Art Unit: 1711

5. Since the prior art rejection is anticipatory, the 37 CFR 1.132 declaration is ineffective to remove the rejection. Furthermore, even if the rejections were obviousness rejections, the showing of the declaration are not commensurate in scope with the claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/om
November 21, 2001


RABON SERGENT
PRIMARY EXAMINER